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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/471,429	12/23/1999	DONALD E. WALLAR II	ST9-99-070	7384

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EXAMINER

RIES, LAURIE ANNE

ART UNIT PAPER NUMBER

2176

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/471,429

Applicant(s)

WALLAR II, DONALD E.

Examiner

Laurie Ries

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed on 8 August 2006, to the Original Application, filed on 23 December 1999.
2. Claims 1, 10, 15, and 20-29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Guck (USPN 5,911,776 -filed on 12/1996, herein after "Guck") in view of Mertama et al. (Patent # 6,629,130).
3. Claims 2-7, 11-14, and 16-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Guck in view of Mertama et al., and Ferrel et al. (USPN 6,230,173 B1 -filed on 07/19'95).
4. Claims 8 and 9 are cancelled. Claims 1-7 and 10-29 are pending in the case. Claims 1, 10, 15, 20, 21, 23, 25, 26, 27, 28, and 29 are independent claims.

Drawings

5. The drawings filed on 12/23/99 are objected to as indicated in the Office action filed 2 May 2006. Formal corrected drawings can be filed at allowance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 10, 15, and 20-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guck (USPN 5,911,776 -filed on 12/1996, herein after "~Guck") in view of Mertama et al. (Patent # 6,629,130).

Regarding independent claims 1, 10, 15, 20, 21, and 23, Guck discloses:

Composing a computer message (on col. 2, lines 1-19 teaches an author could originate a text or message of his own personal format), comprising the steps of: (a) presenting a message composition area for entry of an unformatted message into one text field (on col. 2, lines 1-19, col. 6, lines 10-28, and col. 12, lines 56-65 teaches an author can create its own message or document in his own format such as Rich Text Format (RTF) (unformatted); the RTF is not a tagging language like TIFF, SGML or HTML) and at least one selection field associated with text field (See Guck, col. 16, lines 40-45, Specifically line 44, wherein Guck teaches selection field to select converter). message format selector for selecting an output format from a plurality of formats (col. 16, lines 15-25 and on col. 6, lines 49-64 teaches the user sender can change the document by reformatting it in any one of the formats required for the

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intended recipients); a formatted message display area; converting unformatted message to form a formatted message with format tags of said on of output formats (on col. 5, lines 29-33, col. 6, lines 49-64, and on col. 9, lines 57-65 teaches converting Rich Text format (an untagged format) into TIFF (a tagged format); wherein the document will be formatted in TIFF for display). Presenting message into one text field (col. 12, lines 57-60, wherein the file is a word file. It is inherent that a text field is present) having at least one associated selection field (col. 16, lines 13-23, wherein author creates text file and defines MIME type and selects format. It is inherent that file type is selected (MIME) along with format) and formatted message structured according to output format and selection field (Col 16, lines 15-23, as discussed above. It is inherent that output formatted message is structured in context with selection)

Guck fails to teach assigning format tags to formatted message and formatted message is structured for display based on selection field data. Mertama et al does. Specifically, Mertama teaches assigning format tags to formatted message and formatted message is structured for display based on selection field data as described in col.5, lines 33-col. 6, line 8.

Therefore it would have been obvious for a person with ordinary skill in the art at the time the invention was made to incorporate Mertama's format tags in method of Guck because it provides for functionality and identification of different format which is desired.

Regarding dependent claims 22 and 24, Guck discloses: displaying said formatted message for user review (on col. 7, lines 6-10: teaches text of a document or message can be displayed for review).

Regarding independent claims 25-29, they are substantially similar to claims 20-24 and are rejected under same rational.

7. Claims 2-7, 11-14, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guck in view of Mertama et al., as applied to claims 1, 10, 15, and 20-29 above, and further in view of Ferrel et al. (USPN 6,230,173 B1 -filed on 07/19/95).

Regarding dependent claims 2, 11, and 16, combination of Guck and Mertama discloses the invention substantially as claimed as described supra. However, combination of Guck and Mertama does not explicitly disclose, "message formats include SGML and book manager script".

Ferrel on col. 20, line 57 - col. 21, line 26 and col. 2.3, lines 30-33 teaches converting Rich Text (RTF) into a Multimedia Data Format file (MDF); wherein the MDF is the MPML markup language tagged storage; wherein MPML text derived from SGML and HTML.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Ferrel into Guck and Mertama to provide a way to author documents from Rich Text format (RTF) to be converted into a MDF being a

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MPML markup language tagged storage, as taught by Ferrel, incorporated into the converting of RTF into TIFF, as taught by Guck and Mertama, in order to provide the ability to place embedded objects within the structure of the document in an authoring environment.

Regarding dependent claims 3, 12, and 17, Guck discloses:

a formatted message display area (Duck on col. 5, lines 29-33, col. 6, lines 49-64, and on col. 9, lines 57-65 teaches converting Rich Text format (an untagged format) into TIFF (a tagged format); wherein the document will be formatted in TIFF for display).

Regarding dependent claims 4, 13, and 18, Ferrel discloses:

wherein computer instructions for steps (a) and (b) are implemented in Java script (Ferrel on col. 14, line 65 -col. 15, line 3 teaches scripting controls to respond to actions or automatically perform actions at runtime).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Ferrel into Guck and Mertama to provide a way to author documents from Rich Text format (RTF) to be converted into a MDF being a MPML markup language tagged storage, as taught by Ferrel, incorporated into the converting of RTF into TIFF, as taught by Guck and Mertama, in order to provide the ability to place embedded objects within the structure of the document in an authoring environment.

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Regarding dependent claims 5, 14, and 19, Guck discloses "wherein said unformatted message is a first unformatted message, said formatted message is a first formatted message, said message area further includes a formatted display area" on col. 5, lines 29-32 teaches converting rich text format (RTF) into the TIFF format (tag format).

Ferrel discloses "in response to entry of a second unformatted message into said second message composition area, converting said unformatted message to form a formatted message with format tags of said one of said output formats; and (d) presenting said first and second formatted messages as a concatenated complete message for display in said formatted message display area", on col. 2, lines 36-47 teaches creating and displaying stories that are formatted from text document into SGML or HTML to be displayed in an on-line network; wherein producing documents that are tagged in either the SGML and HTML format (first and second message composition area); col. 3, lines 46-65 and on col. 20, line 57 --col. 21, line 26 teaches converting Rich Text format (RTF) to a MDF that holds is tagged language MPML (converting unformatted message into format tags).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Ferrel into Guck and Mertama to provide a way to author documents from Rich Text format (RTF) to be converted into a MDF being a MPML markup language tagged storage, as taught by Ferret, incorporated into the converting of RTF into TIFF, as taught by Guck, in order to provide the ability to place embedded objects within the structure of the document in an authoring environment.

Regarding dependent claim 6, Guck discloses:

Guck discloses "editing first and second formatted messages and sending a copy of the formatted message to a computer message file" on cot. 6, lines 49-64 teaches author or user sender selects among various formats to reformat his document to send to various recipients and on cot. 12, lines 56-65 teaches creating a file and defining the file in a alternate format. Regarding dependent claim 7, Ferrel discloses:

wherein said first and second composition areas and said formatted message display area are formed in a template that is presented on a web page, and wherein steps (e) and (f) are performed via said web page (Ferret on cot. 3, lines 46-65 teaches using Word template to help author produce documents with valid embedded codes).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Ferrel into Guck and Mertama to provide a way to author documents from Rich Text format (RTF) to be converted into a MDF being a MPML markup language tagged storage, as taught by Ferrel, incorporated into the converting of RTF into TIFF, as taught by Guck, in order to provide the ability to place embedded objects within the structure of the document in an authoring environment.

Response to Arguments

8. Applicant's arguments filed 8 August 2006 have been fully considered but they are not persuasive.

Applicant argues on Pages 14-16 of the Instant Amendment that Guck in combination with Mertama fails to teach an unformatted message. The Office respectfully disagrees. Formatted data is defined as a specific arrangement of data on a disk or other storage medium to meet the established application requirements (See Guck, Column 6, lines 23-25). While Guck teaches that a message may be in a personal format, Guck also teaches that the data is not formatted specifically for a particular application (See Guck, Column 6, lines 10-28), therefore, the data of Guck was unformatted for the receiving application.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR


WILLIAM BASHORE
PRIMARY EXAMINER